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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,212	01/05/2001	Jocelyn Ricard	Q62416	3349
23373	7590	05/27/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PEREZ, JULIO R	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/754,212

Applicant(s)

RICARD ET AL.

Examiner

Julio R Perez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's submission of prior art Byrne (660626A2).

Regarding claims 1 and 2, Byrne discloses a multi-standard mobile telecommunications terminal adapted to operate with base stations of a public cellular network and at least one fixed part of at least one preferred cordless telephone local network (col. 3, lines 19-23, a radio telephone that communicates within a cordless and cellular networks), the terminal including communication means for communicating with each of said networks and switching means including means for searching for a fixed part of a local network and commanding the communication means to operate with one or the other of said networks according to the result of the network search conducted by the search means (col. 3, lines 19 – 31 and 47-51, the multi-mode telephone monitors for more than one radio telephone system and automatically selecting communication in accordance with the monitoring means, which can be set to function preferably in the least inexpensive system, the cordless system), the terminal including means for programming and processing events triggering a search for the fixed part or parts of the

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local networks in which the terminal can operate (col. 3, lines 43- 51, the system comprises means for programming the terminal to execute certain instruction in accordance to predetermined criteria; such criteria may be programmed into the terminal by the user), said programming and processing means activating the search means on the occurrence of programmed triggering events (col. 3, lines 19-53; col. 4, lines 33-49).

Regarding claim 3, Byrne discloses a terminal, wherein the triggering event is a predefined sequence of keystrokes associated with a command of the terminal other than the command which switches the communication means to operate with a preferred local network (col. 3, lines 47-53; col. 4, lines 33-38, the user is able input into the terminal a decided predetermined criteria corresponding to triggering events).

Regarding claim 8, Byrne discloses a terminal, including means for locating fixed parts of the local networks from information supplied by the public cellular network and wherein the triggering event is the fact that the terminal is in a cell of the public network overlapping the coverage area of a cordless telephone local network (col. 3, lines 43-58; col. 4, lines 15-45, the system always tries to locate the cheapest available system, the cordless system, in accordance to the preferences predetermined in the programmed definitions in the criteria. Further, the paragraphs shown read upon the fact that the phone being in an overlapping area should automatically find out that it is located within an overlapping area, and should handover to a cordless system as it is the preferable system).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (660626A2) in view of Van Der Salm (6343220) further in view of Dalsgaard et al. (6226527).

Regarding claim 4, Byrne teach all the limitations as disclosed in claim 1.

Byrne does not explicitly teach means for evaluating the traffic load of a local network as a function of time and wherein the triggering event is the traffic load of the local network falling below a predefined threshold, in particular a threshold defined by the user.

However, the preceding limitation is known in the art of telecommunications.

Van Der Salm teaches a multi-mode terminal that can be set to operate over a specific network during busy hours while the other network is less loaded. Therefore, the network is selected dependent on the time or the traffic load of a particular network (col. 6, lines 22-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon the intelligent network searching multi-mode as taught by Byrne by implementing the system to provide means for traffic load

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evaluation because it would provide the network with the capability to evaluate the traffic load of the local network in function of time

Regarding claim 9, Byrne teach all the limitations as disclosed in claim 1.

Byrne or Van Der Salm do not explicitly teach a terminal, including means for storing the identity of the cell of the public network in which the local network is located and wherein the triggering event is the reception of a signal representing the identity of the base station corresponding to the stored cell identity.

However, the preceding limitation is known in the art of telecommunications.

Dalsgaard et al. teach a storing the identity of the cell of the public network in which the local network (col. 3, lines 14-18, 26-29 and 63-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon the network searching multi-mode as taught by Byrne by implementing the system to provide means for identifying the cell site where the terminal is located because it would provide the network with the capability to know its position and provide means to efficiently and easily select the preferable cordless system.

Regarding claim 10, Dalsgaard et al. teach a terminal, wherein the switching means switch to a searched for local network only if said search means detect a signal transmitted by a fixed part of the searched for local network during a predefined time period after the occurrence of an associated triggering event (col. 4, lines 31-51, the terminal scans within a predetermined period of time).

***Allowable Subject Matter***

5. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The priority art teaches a multi-mode telephone, capable of establishing connection to a cellular network or a cordless network, of searching for local networks, and allowing the user to update parameters.

On the other hand, the applicant teaches means for storing the frequency of use of every network, and calculating the probability of use of each network by the terminal and wherein the triggering event for a local network is the crossing of a probability threshold for use of that network, as recited in claims 5, 6, and 7 respectively.

These limitations, in conjunction with all-limitations of the independent and dependent claim, respectively, have not been disclosed, taught, or made obvious over the prior art of record.

***Response to Arguments***

6. Applicant's arguments filed on 11/22/04 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ***in order to save on battery energy***) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. The applicant argues that Byrne does not teach activating the search means on the occurrence of the programmed triggering events (Page 2, par. 3 of the response).

In the rejection, it has been explained how Byrne meets the claimed invention. For purposes of clarification, the triggering events is, a predetermined criterion, for example, when the user activates the terminal, hence the CCT (Step 301, Fig. 3).

On the occurrence of these triggering events, the search function (monitoring) is activated (Step 304, Fig. 3). Furthermore, the programming and processing is performed by the means of programming and processing (microprocessor, 210). (See col. 6, lines 60 – col. 7, line 1).

In addition, Byrne teaches the user activating the CCT, thereafter the microprocessor (monitors), that is scans, the systems, including the cordless system



availability, based on the triggering of the activation of the CCT terminal (Col. 6, lines 60  
67 – col. 6, line 1; Fig. 3, Steps 302-304).

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R Perez whose telephone number is (703) 305-8637. The examiner can normally be reached on 7:00 - 4:00 PM.

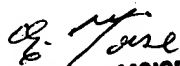
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 703-306-0003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP  
5/18/05

  
**EMMANUEL L. MOISE**  
**SUPERVISORY PATENT EXAMINER**